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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

OBEID, MAMON A

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/690,911	Applicant(s) MAARI, KOICHI	
	Examiner MAMON OBEID	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38- 52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38- 52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination ("RCE") under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 7, 2008 has been entered.

Acknowledgments

2. This communication is in reply to the RCE noted above.
3. Claims 38- 47 have been amended.
4. Claims 48- 52 have been added.
5. Claims 38- 52 are currently pending and have been examined.

Restrictions

6. Restriction to one of the following inventions is required under 35 U.S.C 121:
 - I. Claims 38- 42, drawn to a method, classified in class 705, subclass 51.
 - II. Claims 43- 47 and 48- 52, drawn to a system, classified in class 380, subclass 278.

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In the Instant case, the Inventions as claimed are not be patentably distinct at this time. However, If Applicants amend any claims such that Group I is patentably distinct from Group II, this restriction will be implemented.

Specification

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1), MPEP § 608.01(o), and MPEP § 2181. Correction of the following is required:

- b. “receiving means for receiving” as recited in at least claim 43.
- c. “obtaining means for obtaining” as recited in at least claim 43.
- d. “encrypting means for encrypting” as recited in claim 43.
- b. “adding means for adding” as recited in claim 43.
- c. “transmitting means for transmitting” as recited in claim 43.
- e. “generating means for generating” as recited in claim 43.

Claim Rejections - 35 USC § 112- 1st

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 48- 52, as best understood by the Examiner, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a. Claim 38 recites “receiving a request for specified content from a user terminal” which lacks support in Applicants' original specification. If Applicants believe that such limitation is supported in Applicants' original specification, Applicants should point out such support or disclosure.

b. Claim 38, recites: “transmitting the encrypted content and the added content ID through the user terminal to a player” which lacks support in Applicants' original specification. However, the Examiner noticed that the “transferring” was used to describe the communication between the player and the user terminal (see for example figure 15). Appropriate correction is required.

c. The Examiner submits that no support exists in Applicants' original specification for the following limitations:

i. “a receiving unit that receives a request for specified content from a user terminal” as recited in at least claim 48.

- ii. “an obtaining unit that obtains the specified content from a content provider” as recited in at least claim 48.
- iii. “a encrypting unit that encrypts the specified content using a content key;
an adding unit that adds a content ID of the specified content to the encrypted content” as recited in at least claim 48.
- iv. “a transmitting unit that transmits the encrypted content and the added content ID through the user terminal to a player” as recited in at least claim 48.
- v. “a generating unit that generates a use condition associated with the content ID for specifying use of the specified content in accordance with the use condition” as recited in at least claim 48.
- vi. “the receiving unit, at a time subsequent to the transmitting unit transmits the encrypted content and the added content ID through the user terminal to the player, receives a request for the content key from the player through the user terminal, the request including the content ID, and in response thereto, the transmitting unit transmits the content key and the use condition through the user terminal to the player” as recited in at least claim 48.

Claim Rejections - 35 USC § 112- 2nd

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 38- 52, as best understood by the Examiner, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 38 recites “receiving a request for specified content from a user terminal” which renders the claim vague and indefinite. One of ordinary skill in the art would have been confused as to who specifies the content in question; is the requestor that makes the request specifies the content to be requested? Or is it some other individual, entity or device that specifies the content to be requested? Appropriate clarification is required.

b. In claims 43 and 48, the specification does not clearly link the corresponding structure to:

- i. “receiving means for receiving a request for specified content from a user terminal” as recited in at least claim 43.
- ii. “obtaining means for obtaining the specified content from a content provider” as recited in at least claim 43.
- iii. “encrypting means for encrypting the specified content using a content key” as recited in claim 43.
- iv. “adding means for adding a content ID of the specified content to the encrypted content” as recited in claim 43.

- v. “transmitting means for transmitting the encrypted content and the added content ID through the user terminal to a player” as recited in claim 43.
- vi. “generating means for generating a use condition associated with the content ID for specifying use of the specified content in accordance with the use condition” as recited in claim 43.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 38- 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al, US Patent No. 5,892, 900 (“Ginter”), in view of Stefik et al, US Patent No. 5,629,980, (“Stefik”).

14. **As per claim 38:** Ginter discloses the following limitations:

- a. receiving content from a content provider (figures 77-84; column 313, lines 38-56) and encrypting the content with a content key (figures 17-20; column 223, lines 5-13; column 312, lines 37-43; column 313, lines 38-56).

- b. generating use conditions associated with a content ID and a user ID (figures 19 and 26A, item 940; column 134, lines 29-38; column 155, lines 38-51; column 158, lines 58-65; column/line 159/12-160/33; column 215, lines 42-56; column 299 lines 45-49; column 311 lines 12-34; column 312 lines 37-43).
- c. transmitting the encrypted content having the content ID added thereto to a content server (column/line 307/4-308/43; column 309 lines 58-60; column 314 lines 1024; column/line 315/26- 316/5).
- d. transmitting the encrypted content stored in the content server, the content key and use condition through a user terminal to a player in response to a request from a user (figures 2, 2A and figures 79- 84; column 62 lines 31-50 and 52-64; column 137 lines 35-50).
- e. receiving a request for the content key from the player through the user terminal, the request including the content ID, and in response thereto, transmitting the content key and the use condition through the user terminal to the player (column 141, line 35- column 142, line 26; column 168, line 2- column 169, line 67).

Ginter does not explicitly disclose transmitting the encrypted content, the content key and the usage condition to a player through the user terminal, however, Stefik clearly discloses a rendering repository 203 (see at least figure 2 and column 3, line 50- column 4, line 35) which receives the encrypted digital work, an encryption key and a

set of rights associated with the digital work (see at least column 37 line, 37- column 38, line 50).

Therefore, It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ginter's teachings to include the step of transmitting encrypted digital work, encryption key and the associated usage rights to a rendering system/ player disclosed by Stefik to maintain the security and integrity of the system by storing the digital work within a repository and attaching permanently to the digital work the associated usage rights and fees, See in Stefik (column 6, line 19- column 7, line 5).

15. **As per claim 39:** Ginter discloses generating the content key (column 214, line 3- column 216, line 4).

16. **As per claim 40:** Ginter discloses compressing the specified content (column 68 lines 43-59).

17. **As per claim 41:** Ginter discloses encrypting the content key prior to transmitting the content key (figure 19; column 135 lines 51- 59; column 137 lines 35-50 and 57-64).

18. **As per claim 42:** Ginter discloses executing a process to share a session key with the user and encrypting the use condition using the session key (figure 19;

column 155 line 37- column 156, line 14; column 207 lines 20- 33; column 222 lines 40- 50).

19. **As per claims 43- 47:** the claims recite an apparatus for performing the method of claims 38- 42 and hence, they are rejected under the same reasoning as used in the rejections of claims 38- 42 shown above.

20. **As per claims 48- 52:** the claims recite an apparatus for performing the method of claims 38- 42 and hence, they are rejected under the same reasoning as used in the rejections of claims 38- 42 shown above.

21. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Response to Arguments

22. Applicant's arguments filed June 9, 2008 have been fully considered but they are not persuasive.

Applicants argue on page 9 that "the relied on sections of Ginter describe permissions records ("PERCs"), which control how content may be used and which contain keys to decrypt the content and/or to decrypt keys that can be used to decrypt the content, that are encapsulated together with the content in the same object. (See Figs. 17-19, coi.134 11.29-39, coi.155 11.37-51, and coi.158 11.58-64.) Namely, the content and the permissions records are transmitted together at the same time. Such sections of Ginter are not concerned with receiving a request for permissions records at a time subsequent to transmitting encrypted content and transmitting permissions records at a time subsequent to transmitting encrypted content. However, the Examiner respectfully disagrees. Ginter discloses updating permissions records ("PERCs") for previously registered objects; add or update budget records; add or update user rights records; and add or update load modules (column 142, line 10- 40 and figure 17; column 169, lines 41- 67)).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mamon Obeid whose telephone number is (571) 270-1813. The examiner can normally be reached on Mon-Fri 9:30 AM- 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mamon Obeid
Examiner
Art Unit: 3621
July 25, 2008

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621